

Remarks

Examiner has required election of one of nine (IX) groups as well as election of a single compound.

Response to Restriction Requirement

Applicants hereby provisionally elect Group I, claims 1-6, 8-10 and 21 drawn to products of structure I, wherein the variables are neither cyclic nor cyclic substituted, and as the compound, compound 20, wherein X is O, R₁ is H, R₂ is Cl and R₃ is Cl, with traverse.

Applicants that Examiner has mistakenly separated a compound and its use and request that Group VII, claims 12-20 drawn to the process of using products of Group I, be recombined and searched with Group I.

Claims readable on compound 20 in Group I include 1, 2, 3, 4, 5, 6, 8, 9, 10, and 21. Claims readable on compound 20 in Group VII include 12, 13, 14, 15, 16, 17, 18, 19, and 20.

Applicants assert that Groups I and VII, contrary to the assertion of the Examiner, do relate to a single inventive concept when compound 20 is elected.

37 C.F.R. 1.475(a) states that unity of invention under PCT Rule 13 is satisfied when there is a technical relationship among those inventions defined by the claims which involves "one or more of the same or corresponding special technical features." This unifying special technical feature is that which defines a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. PCT Rule 13.2 and the PCT Administrative Instructions, Annex B, Part 1(b).

First, Applicants note that the structure of Simons recited by the Examiner does not teach or contemplate compound 20 of the present application, and thus does not teach the technical feature linking the subject matter of the Groups. Additionally, the structure of Simons does not, for example teach compounds 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, and 30 of Table 1 (page 39 of specification) . As only 23 and 24 have cyclic groups as possible substituents in R groups, Simons has no impact on the others that do not have cyclic substituents in the R groups and Applicants requested that they be rejoined with compound 20.

Here, the special technical feature is the general structure I, or its derivative, compound 20 as elected herein. All claims in Groups I and VII contain this feature.

Group VII (claims 12-20) utilizes a compound having the general structure of formula I of Group I for treating cancer or regulating cell proliferation. Thus, both Groups VII and I do have the same general technical feature regarding a compound having the general structure of I in Group I. Group I, claims 1-6, 8-10 and 21 drawn to products of structure I, encompasses compounds comprising the generic compound I, of which compound 20 is a species. Thus, all claims of Groups I and VII encompass compound 20, or its parent structure, and Group VII further relates to the use. Therefore, searching the compounds of for the claims of one group would necessarily encompass the claims of the other group. That is, the search for one group of Groups I and VII, would be coextensive with the other, does not require independent searches, and furthermore does not entail a burdensome search.

Claims which possess a unifying special technical feature and which are drawn to a product and process of use of said product have unity of invention. 37 C.F.R. 1.475(b)(2). PCT Rule 13 does not prohibit product and process of use claims from being examined in a single application, even if both the claimed product and process can be used separately, in materially different ways. Rather, PCT Rule 13 allows for such claims to be examined together in a single application if all claims contain the same or similar technical feature. Thus, the Group I and Group VII claims, which possess the unifying special technical feature described above, have unity of invention. Because all claims of Groups I and VII have the same special technical feature, and the claimed generic or species product in Group I is used in Group VII, the pending claims of Groups I and VII have unity of invention. Applicants request that the Group I and VII claims be rejoined for examination on the merits under 37 C.F.R. 1.475(b)(2).


Based on the foregoing, Applicants respectfully request reconsideration and withdrawal of the restriction requirement, to the extent described above.

Conclusion

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (434) 243-6103.

Respectfully submitted,

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